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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,492	10/31/2000	Magnus Hollstrom	34650-607PT	2948
7590	05/20/2004		EXAMINER	
Spencer C Patterson Jenkens & Gilchrist PC 3200 Fountain Place 1445 Ross Avenue Dallas, TX 75202-2709			PATEL, KANJIBHAI B	
			ART UNIT	PAPER NUMBER
			2625	
			DATE MAILED: 05/20/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/703,492	HOLLSTROM ET AL.
	Examiner	Art Unit
	Kanji Patel	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 April 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 9, 10 and 16-19 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8, 11-15, 20-27, 29-32, 37 and 38 is/are rejected.
- 7) Claim(s) 28 and 33-36 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 October 2000 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 5-8.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. Applicant's provisionally election with traverse of Group I (claims 1-8, 11-15 and 20-38) in Paper No. 11 is acknowledged. The applicant did not present any arguments. The requirement is still deemed proper and is therefore made FINAL.

Drawings

2. Drawings filed on 10/31/00 are in poor quality. Accordingly, new drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 11, 20-27, 29-32 and 37-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Dymetman et al. (hereinafter referred to as Dymetman) (US 6,330,976 B1).

For claim 1, Dymetman discloses a system for electronically recording a transaction (column 8, lines 41-44), comprising:

a formatted surface including a data entry field that includes an address pattern (column 8, lines 55-67; figures 3-7; 508 in figure 11; figures 14-15; a special type of

marking medium or a coded substrate corresponds to a formatted surface having address pattern);

an electronic reading device (502 in figures 1-2; figure 8; 506 in figure 9; figure 11; figures 14-15; electronic pen is a reading device) including a position sensor (502; 802 in figure 8; 506 in figures 9 and 11) for detecting positions of the electronic reading device relative to the address pattern as information is written in the data entry field, wherein the positions of the electronic reading device are used to generate an electronic reproduction of the written information; and

a server (at least at column 9 line 64 to column 10 line 5; column 9, lines 1-5) for receiving the electronic reproduction of the written information.

For claim 11, see the rejection of claim 1 above.

For claim 20, Dymetman discloses an electronic reading system (figures 1-2), comprising:

an electronic reading device (502 in figures 1-2; figure 8; 506 in figure 9; figure 11; figures 14-15; electronic pen is a reading device) including a position sensor (502; 802 in figure 8; 506 in figures 9 and 11) for detecting positions of the electronic reading device relative to an address pattern on a formatted surface (column 8, lines 55-67; column 9, lines 6-55; figures 3-7; 508 in figure 11; figures 14-15; a special type of marking medium or a coded substrate corresponds to a formatted surface having address pattern);

a memory for storing a preselected code (column 9, lines 6-55); and

a processor for converting detected positions into an entered code and for comparing the entered code with the stored preselected code, wherein the electronic reading device is enabled for at least one function if the entered code matches the stored preselected code (column 9 line 16 to column 10 line 8).

For claim 21, Dymetman discloses the system wherein the electronic reading device (figure 8) further comprises the memory (806, 809 in figure 8) and the processor (808 in figure 8).

For claim 22, Dymetman discloses the system wherein the stored preselected code comprises a personal identification (PIN) number code (column 17, lines 39-43; column 15, lines 39-44).

For claim 23, Dymetman discloses the system wherein the PIN code comprises a plurality of symbols selected from a set of symbols that can be written with one stroke (column 17, lines 29-30).

For claim 24, Dymetman discloses the system wherein the electronic reading device includes a writing means (figures 1, 14-15).

For claim 25, Dymetman discloses the system wherein the formatted surface comprises a laminated paper such that the writing means does not leave markings on the formatted surface (column 3, lines 51-56; machine readable markings can be invisible).

For claim 26, Dymetman discloses the system wherein the writing means can be selectively disabled such that the writing means does not leave markings on the

formatted surface (figure 2; column 3, lines 51-56; machine readable markings can be invisible).

For claim 27, Dymetman discloses the system wherein the electronic reading device vibrates in connection with an entry of the code ((column 17, lines 20-30; a pointer movement reads on vibration).

For claim 29, Dymetman discloses the system wherein the electronic reading device (502) remains in an enabled state for a predetermined amount of time (column 27, lines 45-53).

For claim 30, Dymetman discloses a method of enabling an electronic reading device (figures 1-2, 11) comprising the steps of:

determining a plurality of positions of an electronic reading device relative to an address pattern by detecting portions of the address pattern adjacent to the electronic reading device (column 9, lines 6-55);

converting the plurality of positions into an entered code (column 9, lines 6-23); comparing the entered code with a preselected code (column 9, lines 24-39); and enabling at least one function of the electronic reading device if the entered code corresponds to the preselected code (column 9 line 40 to column 10 line 8).

For claim 31, Dymetman discloses the method wherein the plurality of positions correspond to a plurality of handwritten symbols (column 17, lines 29-35; column 22, lines 61-65), the step of converting the plurality of positions into an entered code involving performing a handwriting recognition operation.

For claim 32, Dymetman discloses the method wherein each of the plurality of positions corresponds to a field associated with a specific symbol (column 17, lines 29-35; column 22, lines 61-65), the step of converting involving identifying the specific symbol corresponding to each position.

For claim 37, Dymetman discloses the method wherein the electronic reading device includes a writing tip, the address pattern included on a laminated surface such that the writing tip does not leave marks on the surface (figure 11; column 3, lines 51-56; column 7, lines 43-52).

For claim 38, Dymetman discloses the method wherein the electronic reading device includes a writing tip, further comprising the step of disabling the writing tip such that the electronic reading device does not leave marks in connection with a code entry (figure 11; column 3, lines 51-56; column 7, lines 43-52).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-8 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman et al. (US 6,330,976 B1) as applied to claims 1, 11, 20-27, 29-32 and 37-38 above and further in view of Oz (US 5,509,692).

For claim 2, Dymetman does not clearly disclose a negotiable instrument. However, Oz discloses banking methods comprising negotiable instruments such as a credit card voucher, check, traveler's check or the like as shown at least in column 4, lines 7-10. It would have been obvious to a person skilled in the art to use negotiable instrument as shown by Oz for marking medium area that has marking encoding an identifier for producing action through a network of Dymetman because such a modification will make the system of Dymetman to provide verification information such as signature, identification number of the authorized signatory of the check as shown by Oz at column 3 line 64 to column 4 line 6.

For claim 3, Oz discloses the system wherein the server (22) further stores the received electronic reproduction in connection with a user account associated with the electronic reading device (figures 2A-2C).

For claim 4, Oz discloses the system wherein the data field comprises a signature field (figures 1A-1A), the server (22) further operating to compare the electronic reproduction of the written information with a stored user signature (column 4, lines 11-24; figure 2A).

For claim 5, Oz discloses the system wherein the server (22) authorizes a transaction if the electronic reproduction corresponds to the stored user signature (column 4, lines 11-24).

For claim 6, Oz discloses the system wherein the server authorizes a transaction based on a determination of whether the formatted surface is allocated for use in connection with the electronic reading device (column 4, lines 11-24).

For claim 7, Oz discloses the system wherein the data field comprises a personal identification number (PIN) field (figures 1C, 2C), the server further operating to compare the electronic reproduction of the written information with a stored PIN .

For claim 8, Oz discloses the system wherein the electronic reading device ciphers the electronic reproduction of the written information for transmission to the server (2A-2C).

For claim 12, see the rejection of claim 2 above.

For claim 13, see the rejection of claim 4 above.

For claim 14, Oz discloses the method further comprising step of sending the plurality of positions to a server for providing confirmation of the negotiable instrument (figures 2A-2C).

For claim 15, Oz discloses the method further comprising the step of enabling the electronic reading device only if a personal identification number (PIN) written with the electronic reading device corresponds to stored PIN data (figure 2C).

Allowable Subject Matter

5. **Claims 28 and 33-36** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Other prior art cited

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cragun et al. (US 5,804,803) disclose a mechanism for retrieving information using data encoded on an object.

Sinden et al. (US 5,333,209) disclose a method of recognizing handwritten symbols.

Parthasarathy (US 6,275,611 B1) disclose a handwriting recognition device, method and alphabet, with strokes grouped into stroke sub-structures.

Verrier et al. (US 5,349,139) disclose an architecture for communication of remote devices to a digitizing display.

Epperson (US 5,247,137) discloses an autonomous computer input device and marking instrument.

D'Alessio et al. (US 5,441,309) disclose a negotiable instrument.

Lee (US 5,422,959) discloses a signature verification apparatus and method utilizing relative angle measurements.

Contact information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kanji Patel** whose telephone number is (703) 305-4011. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 6:30 p.m. Friday off.

If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, **Mehta, Bhavesh**, can be reached on (703) 308-5246.

Any inquiry of general nature or relating to the status of this application should be directed to the **Group receptionist** whose telephone number is (703) 305-4700.

The **Fax number** for this group is (703) 872-9314.



Kanji Patel
Patent Examiner
Group Art Unit 2625
May 14, 2004